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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/722,114 | 11/25/2003 | Michael Z. Hoemann | SPV-048.02 | 4865 |

25181 7590 07/26/2004

FOLEY HOAG, LLP
PATENT GROUP, WORLD TRADE CENTER WEST
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EXAMINER

DESAI, RITA J

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1625

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,114

Applicant(s)

HOEMANN, MICHAEL Z.

Examiner

Rita J. Desai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1 in part, drawn to a compound of formula A wherein R1 is an aryl, R2 is ROalkyl or (R)2N-alkyl, R (S)-alkyl, (R)2Ncycloalkyl, (R)2N cycloalkyl or RS-cycloalkyl, R3 and R4 are H, alkyl or F or -OR, (R is a non hetero ring R5 is a phenyl or a thiophene classified in class 546 and various subclasses.
- II. Claim 1 in part, drawn to compounds of formula A wherein R1 is an aryl, R2 is R-O alkyl, (R)2N-alkyl, R (S)-alkyl (R)2Ncycloalkyl, (R)2N cycloalkyl or RS-cycloalkyl, R3 and R4 are H, F or alkyl or OR, R is non hetero ring containing group R5 is *other than* a phenyl or a thiophene classified in class 546 and various subclasses. A further election of a single disclosed species is required.
- III. Claim 1 in part, drawn to compounds of formula A wherein R1 is an aryl, R2 is (R)2N-alkyl, R (S)-alkyl, (R)2Ncycloalkyl, (R)2N cycloalkyl or RS-cycloalkyl R3 and R4 connected via a covalent bond to form to combine to give a cycloalkyl ring and R5 is a phenyl or thiophene, classified in class 546 and subclasses. (this group was previously elected and allowed in US 6656953 patent).
- IV. Claim 1 in part, drawn to compounds of formula A wherein R1 is an aryl, R2 is ROalkyl or (R)2N-alkyl, R (S)-alkyl (R)2Ncycloalkyl, (R)2N cycloalkyl or RS-cycloalkyl, R3 and R4 are other than H, alkyl or F, or a hetero group, R5 is a

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phenyl or a thiophene, classified in class 546 and various subclasses. A further election of a single disclosed species is required.

V. Claim 1 in part, drawn to compounds of formula A wherein R1 is an aryl, R2 is ROalkyl or (R)2N-alkyl, R (S)-alkyl, (R)2Ncycloalkyl, (R)2N cycloalkyl or RS-cycloalkyl, R3 and R4 are a hetero group and R5 is a phenyl or a thiophene classified in class 546, 544, 548 or 549 and various subclasses.

VI. Claim 1 in part, drawn to compounds of formula A wherein R1 is an hetero aryl, R2 is ROalkyl or (R)2N-alkyl, R (S)-alkyl, and R3 and R4 are non-hetero group, R5 is an phenyl or a thiophene, classified in various classes and subclasses.

VII. Claim 1 in part, drawn to compounds of formula A wherein R1, R, R3, R4 and R5 are other than in the above groups, classified in various classes and subclasses. A further election of a single disclosed species is required. This group may be subject to further restriction.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions has so many variables with the R1 - R5 that they do not have a common core.

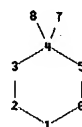
When a search on the core was done it gave numerous iterations indicating that.

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A preliminary search of the core gave numerous iterations, indicating that the compounds were not a novel contribution over the prior art of record.

Structure attributes must be viewed using STN Express query preparation.

=>



=> s 11

SAMPLE SEARCH INITIATED 17:06:36 FILE 'REGISTRY'

SAMPLE SCREEN SEARCH COMPLETED - 100259 TO ITERATE

1.0% PROCESSED 1000 ITERATIONS 7 ANSWERS

INCOMPLETE SEARCH (SYSTEM LIMIT EXCEEDED)

SEARCH TIME: 00.00.01

FULL FILE PROJECTIONS: ONLINE **INCOMPLETE**

BATCH **INCOMPLETE**

PROJECTED ITERATIONS: EXCEEDS 1000000

PROJECTED ANSWERS: EXCEEDS 12447

L2 7 SEA SSS SAM L1

The search did not run to completion indicating that the core is not the applicants contribution to the prior art.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I to any of the II-VII groups, restriction for examination purposes as indicated is proper.

A telephone call was made to Dr. Dana Gordon on 7/23/2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants preserve their right to file a divisional on the cancelled non-elected subject matter in due course without prejudice.

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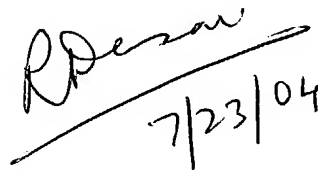
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rita J. Desai
Primary Examiner
Art Unit 1625

R.D.
July 23, 2004


7/23/04